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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,122	12/17/2001	Paul Joseph Datta	15,837	4922

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Eric T. Krischke  
Pauley Petersen Kinne & Erickson  
Suite 365  
2800 West Higgins Road  
Hoffman Estate, IL 60195

EXAMINER

KIDWELL, MICHELE M

ART UNIT PAPER NUMBER

3761

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/026,122	<b>Applicant(s)</b> DATTA ET AL.	
	<b>Examiner</b> Michele Kidwell	<b>Art Unit</b> 3761	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 5/15/06.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17,22-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The term “second fit range” is not supported by the originally filed specification.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 29 – 36 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for additional components being added in a manner so as not to tie up more than 220mm of the potential 370mm fit range, does not reasonably provide enablement for a component providing a fit range not greater than about 150mm less. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

150mm less could reasonably include 151mm or even 155m which according to the instant specification is unacceptable and unsupported.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 6, 16 – 17, 22 – 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ando et al. (US 5,370,634).

With respect to claims 1 and 2, Ando et al. (hereinafter “Ando”) discloses a prefastened, refastenable absorbent article, comprising: an outer cover extensible in a lateral direction of the prefastened absorbent article and having a moisture barrier; a bodyside liner at least partially bonded to the outer cover and extensible in the lateral direction; and an absorbent core positioned between the outer cover and the body side liner; the outer cover, bodyside liner and the absorbent core defining a chassis having a waist opening, wherein the prefastened absorbent article has a percent fit range of at least about 33% as set forth in col. 4, lines 11 – 26 and in the figures.

The examiner contends that the claimed percent fit range is a product by process limitation that does not lend anything structurally to the claim. The applicant is reminded that:

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-

by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

As to claim 3, Ando discloses a prefastened absorbent article further comprising an elastic fit panel (10) attached to the chassis as set forth in figure 1.

With reference to claim 4, Ando discloses a prefastened absorbent article wherein the chassis further comprises an elastic first side panel (14) and a laterally opposing elastic second side panel (14) as set forth in figures 1 – 2.

Regarding claim 5, Ando discloses a prefastened absorbent article further comprising a first fastener (6) bonded to the first side panel and a laterally opposing second fastener (6) bonded to the second side panel as set forth in figures 1 – 2.

With respect to claim 6, Ando discloses a prefastened absorbent article further comprising at least one attachment panel (8) attached to a front waist region of the absorbent article, wherein each of the first fastener and the second fastener are releasably attached to the attachment panel as set forth in col. 6, lines 38 – 41.

As to claims 16 and 17, Ando discloses a prefastened absorbent article comprising a diaper and/or training pants as set forth in the figures.

With reference to claim 22, Ando discloses a prefastened absorbent article, comprising: a chassis having a front waist region, a back waist region and a crotch region intermediate the front waist region and the back waist region, the chassis defining a waist opening; an outer cover having a moisture barrier; a bodyside liner at

least partially bonded to the outer cover; and an absorbent core positioned between the outer cover and the bodyside liner as set forth in col. 4, lines 11 – 26 and in the figures.

Regarding claim 23, Ando discloses a prefastened absorbent article wherein the chassis comprises an elastic material as set forth in col. 2, lines 31 – 48.

Claims 1 – 3, 10 – 12, 15 – 17, 22 – 23 and 26 – 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Arndt et al. (WO 99/55265).

With respect to claims 1 and 2, Arndt et al. (hereinafter “Arndt”) discloses a prefastened, refastenable absorbent article, comprising: an outer cover extensible in a lateral direction of the prefastened absorbent article and having a moisture barrier; a bodyside liner at least partially bonded to the outer cover and extensible in the lateral direction; and an absorbent core positioned between the outer cover and the body side liner; the outer cover, bodyside liner and the absorbent core defining a chassis having a waist opening, wherein the prefastened absorbent article has a percent fit range of at least about 33% as set forth on page 9, 1<sup>st</sup> paragraph.

The examiner contends that the claimed percent fit range is a product by process limitation that does not lend anything structurally to the claim. The applicant is reminded that:

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

As to claim 3, Arndt discloses a prefastened absorbent article further comprising an elastic fit panel attached to the chassis as set forth on page 9, 1<sup>st</sup> paragraph.

With reference to claims 10 and 26 – 27, Arndt discloses a prefastened absorbent article of claim 1, further comprising a spacer material at least partially bonded to the outer cover as set forth on page 71, 1<sup>st</sup> full paragraph.

With reference to claims 11 – 12, Arndt discloses a prefastened absorbent article further comprising at least one extensible containment flap positioned along a first side edge of the prefastened absorbent article and a second extensible containment flap positioned along a laterally opposing second side edge of the prefastened absorbent article as set forth on page 9, 1<sup>st</sup> paragraph.

As to claim 15, Arndt discloses a prefastened absorbent article further comprising a surge layer, the surge layer one of elastic and extensible in a lateral direction of the prefastened absorbent article as set forth on page 70, last paragraph.

As to claims 16 and 17, Arndt discloses a prefastened absorbent article comprising a diaper and/or training pants as set forth in figure 1.

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With reference to claim 22, Arndt discloses a prefastened absorbent article, comprising: a chassis having a front waist region, a back waist region and a crotch region intermediate the front waist region and the back waist region, the chassis defining a waist opening; an outer cover having a moisture barrier; a bodyside liner at least partially bonded to the outer cover; and an absorbent core positioned between the outer cover and the bodyside liner as set forth on page 9, 1<sup>st</sup> paragraph.

Regarding claim 23, Arndt discloses a prefastened absorbent article wherein the chassis comprises an elastic material as set forth on page 9, 1<sup>st</sup> paragraph.

With reference to claim 28, see the rejection of claims 1, 10 – 12 and 15.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 – 9, 13 – 14, 24 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Ando et al. (US 5,370,634).

The difference between Ando and claim 7 is the provision that the attachment panel comprises a loop material, which is extensible in a lateral direction.

Ando provides a tape fastener as opposed to a hook and loop type fastener as set forth in col. 4, lines 29 – 37.



It would have been obvious to modify the fastener of Ando by providing a hook and loop type fastener instead of a tape fastener since the substitution of one fastener for another is within the level of one of ordinary skill in the art.

With respect to claim 8, Ando teaches a first fastener and the second fastener are laterally separated by at least about 2.0 inches with respect to the attachment panel as set forth in col. 10, lines 12 – 36.

As to claim 9, Ando teaches an attachment panel that is passively bonded to a back waist region of the absorbent article as set forth in col. 7, line 67 to col. 8, line 16.

As to claims 13 and 14, see the rejections of claims 7 and 8.

The difference between Ando and claim 24 is the provision that the outer cover and the bodyside liner are one of elastic and extensible in a certain direction.

Ando discloses an outer cover and the bodyside liner that are one of elastic and extensible as set forth in col. 5, lines 30 – 54.

Absent a teaching of criticality and/or unexpected result, the examiner contends that the direction in which the materials are one of elastic and extensible is an obvious matter of design choice that does not patentably distinguish the claimed invention from the prior art.

As to claim 25, see the rejection of claim 24.

### ***Response to Arguments***

Applicant's arguments filed May 25, 2005 have been fully considered but they are not persuasive.

With respect to the applicant's argument that neither Ando nor Arndt disclose an outer cover and/or bodyside liner that is extensible in a lateral direction, the examiner disagrees. The term extensible is defined as being capable of being stretched. Both references utilize materials that are capable of being stretched in the lateral direction as claimed even though the materials may not expressly teach such stretching.

While the examiner maintains that the claimed "percent fit range" is a product by process limitation because the applicant is attempting to define the invention by what it does rather than by what it is, the examiner also makes note of the fact that the originally filed specification discloses that the percent fit range can be achieved by "mixing and matching" various components which are included in both the Ando and Arndt reference.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 571-272-4935. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Michele Kidwell  
Primary Examiner  
Art Unit 3761